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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,511	11/30/2000	Hiroaki Ishizuka	197792US28	8903

22850 7590 01/26/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ALPERT, JAMES M

ART UNIT	PAPER NUMBER
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3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/725,511

Applicant(s)

ISHIZUKA, HIROOAKI

Examiner

James Alpert

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

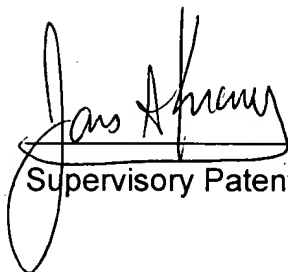
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The following communication is in response to Applicant's appeal brief filed on 07/20/2005. The new Examiner to this application has reviewed both the final rejection and corresponding appeal brief. In view of said brief, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below, and a Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

 1/22/07

Supervisory Patent Examiner

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 & 42 are rejected under 112(2) because there is insufficient antecedent basis in the independent claims to support the limitations in the dependent claims. Claims 19 and 42 recite the step and means for:

issuing a paper bill for said transaction if said financial information is not valid.

The examiner would observe that Claims 1 and 24 do not recite any conditional steps. That is to say, the claims only recite a positive determination that a customer is an acceptable risk and communicating the approval thereof. There is no basis to assume that any financial information would be found invalid. Appropriate correction is required, and Applicant is requested to look for similar types of ambiguities and inconsistencies in the other claims.

Claim Rejections - 35 USC § 103

The text of 35 U.S.C. §103, which is not included in this action, can be found in a prior Office action. After due consideration, the Examiner is of the opinion that the elements of Applicant's invention are taught by some combination of Fischer, U.S. Patent Application Publication #2002/0010638 and Mandler et al, U.S. Patent 5,732,400, and minor modifications thereto. Claims 1-46 are therefore rejected over Fischer in view of Mandler.

With regard to Claim 1, 24, Fischer teaches the method and system comprising:

storing a customer's financial information in a supplier computer system based on an off-line transaction between a customer and a supplier; (Paras. 31-32 describing setting up an account with identifying information and payment techniques. Also see Para. 37)

beginning an on-line purchase by the customer with the supplier and communicating to a server computer by the customer; (Paras. 27 and 36, each describing embodiments where the user goes "on-line" to consummate a transaction)

To the extent that credit card information is provided by a buyer/user in Fischer, it is inherent that the card would be run through the normal card validation checks to establish that the buyer is an acceptable credit risk. That is to say, "determining" is inherently done in Fischer based on the information collected off-line. Still, a better expression of this risk determination can be seen in Mandler.

Mandler discloses many things, and the Examiner would like to point out initially that Mandler expressly teaches an off-line registration process at (Col. 6, lines 19-21 & Col. 11, lines 28-32). However, the thrust of Mandler involves the credit risk determination, followed by the RFQ and ordering process. The credit risk determination process is first described at (Col. 6, line 54 – Col. 7, line 3). Mandler attempts to ensure that potential purchasers will always be reliable trading partners. Thus Mandler teaches:

determining that the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction;

Mandler also teaches:

communicating to the customer that the on-line purchase has been approved, after said determining step determines that the customer is an acceptable credit risk.
(Col. 4, lines 35-38)

Further, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Fischer, related to acquiring off-line financial and identification information, prior to an on-line purchase, with the teachings of Mandler, related to making a credit risk determination based on acquired financial information, and communicating that said determination is positive. The motivation for such a combination is well known to the ordinary practitioner in the financial arts, and is simply to diminish the number of fraudulent and/or excessively risky transactions engaged in by a vendor. The Examiner would point out that this motivation is well known, and is the reason behind many, many electronic-commerce processes: how to make transactions safe, secure, and with the lowest amount of risk possible.

With regard to Claims 2-5 and 25-28, these claims involve identifying a particular type of transaction whereby financial information is obtained. The particular transaction described are leases or purchases of copying and imaging equipment. Initially, the Examiner would point that the word "transaction" is quite broad, and can be interpreted as "a communicative action or activity involving two parties or thing that reciprocally affect or influence each other." See the Merriam-Webster online dictionary definition, listed in the Notice of References Cited. Thus as to the independent claim, on which these claims are based, the relationship as described in Fischer adequately reflects the definition above.

As to the exact dependent claims, Mandler adequately describes, in the background section of that patent, that there are a variety of different types of corporate, business, and seller/purchaser relationships that would benefit from, and make use of, the process described in Mandler. Any specific transaction type (such as those described by Applicant) involves only a species of the genus "transaction" type disclosed by Mandler.

With regard to Claims 6-7 and 29-30, these claims focus on how the determination is made as to credit qualification, and in particular, whether satisfactory payments have been made on a lease or purchase of a copying or imaging machine. It is fairly clear that there is leeway in Mandler as to how credit risk determinations are made, and considerations of performance in previous relationship would normally be contemplated. See (Mandler, Col. 6, line 54 - Col. 7, line 3). A specific type of credit analysis, such as that proposed by Applicant, involves only a species of the genus "credit risk determination" type performed in Mandler.

With regard to Claims 8-15, 20-21 & 31-38, 43-44 these claims focus exclusively on bill distribution and presentment. These claims are unrelated to the concept of using previously acquired off-line information in making a credit risk determination to a current transaction. Mandler generally teaches these principles at (Col. 11, lines 4-14). Still, the Examiner can safely say that all of these bill presentment and distribution ideas are old and well known in the art: there is nothing novel in emailing a bill to a customer. The Examiner takes Official Notice of these claims, and observes that it would have been obvious to one of ordinary skill in the art at the time

Applicant's invention was made to modify the teachings of Fischer in combination with Mandler to include a variety of bill presentment options. The motivation for such a combination is within the general knowledge of one of ordinary skill in the art and is simply to provide as many options as possible, to both vendor and customer, so as to facilitate prompt payment.

With regard to Claims 16-17 and 39-40, these claims involve debiting a bank account electronically. Although Fischer does not expressly teach a debit mechanism, these limitations are found in Mandler at (Col. 11, lines 4-14). Further it would have been obvious to combine the references, for the same reason as given above in Claims 1 and 24.

With regard to Claims 18,41, Fischer teaches a method and system comprising: charging a third party credit card of the customer for the on-line transaction.
(Para. 32)

With regard to Claims 19,42, Fischer teaches a method and system comprising: issuing a paper bill for said transaction if said financial information is not valid.
(Col. 11, lines 4-14)

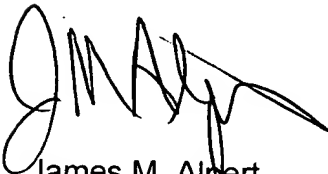
With regard to Claims 22-23 and 45-46, these claims involve identifying the type of products purchased online by the customer. These claims, however, are unrelated to the concept of using previously acquired off-line information in making a credit risk determination to a current transaction. Mandler adequately describes, in the background section of that patent, that there are a variety of different types of products used by consumers as a result of the multiple corporate, business, and seller/purchaser relationships that are commonplace in today's economy. A purchase of a specific

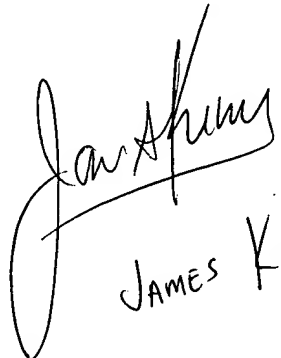
product type (such as that described by Applicant) frankly involves only a species of the genus "product" type disclosed by Mandler. As such these claims are rejected under a Fischer / Mandler combination.

Conclusion

THIS ACTION IS NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer, can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.


James M. Alpert
January 22, 2007

 1/22/07
JAMES KRAMER